

DISCUSSION OF THE AMENDMENT

The specification has been amended by capitalizing HENSCHTEL MIXER and by correcting an error in the heading for Comparative Example 2.

Claim 1 has been amended by incorporating the subject matter of Claim 17 therein, and inserting a Markush group, as supported in the specification at the paragraph bridging pages 20 and 21. Claim 5 has been amended by changing "comprises" to --comprise--, and by inserting -- urea- -- before "modified".

No new matter is believed to have been added by the above amendment. Claims 1-16 are now pending in the application.

REMARKS

The rejections of claims other than Claim 17 under 35 U.S.C. § 102(a) and/or 35 U.S.C. § 103(a), are respectfully traversed. All of the presently-pending claims contain the limitations of Claim 17. Accordingly, it is respectfully requested that these rejections be withdrawn.

The rejection of Claims 1-13, 16 and 17 under 35 U.S.C. § 103(a) as unpatentable over WO 02/056116, as evidenced by U.S. 2004/0053155 A1 (Emoto et al), combined with U.S. 6,037,090 (Tanaka et al), is respectfully traversed.

The present invention is drawn to a toner comprising a binder resin comprising a urea-modified polyester resin and a colorant master batch comprising a colorant, a resin, and a polymeric pigment dispersant selected from a Markush group of such dispersants, wherein the toner is prepared by a method that includes, *inter alia*, the pigment dispersant as part of the master batch. Emoto et al discloses a toner obtained by dispersing an oil dispersion, containing an isocyanate group-containing polyester prepolymer dissolved in an organic solvent, a pigment colorant dispersed therein and a releasing agent dissolved or dispersed therein, in an aqueous medium in the presence of inorganic fine particles and/or polymer fine particles, reacting the prepolymer in the dispersion with a polyamine and/or a monoamine containing an active hydrogen-containing group to form a urea-modified polyester resin having a urea group, and by removing the liquid medium from the dispersion containing the urea-modified polyester resin, wherein the pigment colorant contained in the toner has a dispersion diameter, in terms of a number average diameter, of 0.5  $\mu\text{m}$  or less and in that particles of the pigment colorant having a number average diameter of 0.7  $\mu\text{m}$  or more account for 5% by number or less [0015]. The Examiner relies on Example 1 therein. The Examiner acknowledges that Emoto et al does not disclose the use of a pigment dispersant or a pigment dispersant auxiliary therein. The Examiner thus relies on Tanaka et al.

Tanaka et al is concerned with improving the dispersibility of a colorant and a releasing agent in a toner to overcome various problems of the prior art (column 3, lines 24-29), which involves dissolving or dispersing into an organic solvent, a binder resin and a colorant dispersed by a dispersant polymer having an acid value of from 1 mgKOH/g to 27 mgKOH/g and an amine value of from 1 to 100, to prepare oil phase components, and dispersing the oil phase components into an aqueous solution, thereby forming particles (paragraph bridging columns 3 and 4).

It is not clear why one skilled in the art would combine Emoto et al and Tanaka et al without the present disclosure as a guide. However, even if combined, the result would not be the presently-claimed invention, since Tanaka et al neither discloses nor suggests any of the presently-recited polymer dispersants. Since Tanaka et al's dispersant requires a positive amine value, it necessarily must contain nitrogen. Nor does either reference disclose or suggest a colorant master batch including a pigment dispersant.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 14 and 15 under 35 U.S.C. § 103(a) as unpatentable over U.S. 5,430,526 (Ohkubo et al) combined with Emoto et al and Tanaka et al, is respectfully traversed. The Examiner relies on Ohkubo et al for the apparatus limitations of Claims 14 and 15. But even if the toner resulting from combining Emoto et al and Tanaka et al were used in this apparatus, the result would still not be the presently-claimed invention, for reasons discussed above with regard to the rejection over the combination of Emoto et al and Tanaka et al. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection of Claim 5 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. Indeed, the rejection is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the rejection be withdrawn.

The objection to Claim 5 is now moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

The objection to the specification with regard to trademarks is respectfully traversed. Indeed, the objection would now appear to be moot in view of the above-discussed amendment. Accordingly, it is respectfully requested that the objection be withdrawn.

Regarding paragraph 4 of the Office Action, Applicants respectfully submit that the List of Related Cases was submitted in a proper manner, since Mr. Nicholas P. Godici, former Commissioner for Patents, stated on August 4, 2004 that copies of cited pending applications are no longer required. Applicants have satisfied their duty of disclosure by providing this listing to the Examiner. The OG Notice of October 19, 2004 (**copy enclosed**) does not state that its effects are not retroactive.

With regard to the first paragraph at page 4 of the Office Action, Applicants note that U.S. Application 10/674,358 is the **present** application.

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

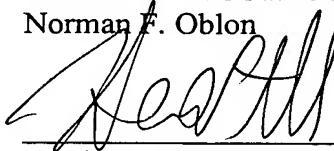
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Respectfully submitted,

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## **United States Patent and Trademark Office OG Notices: 19 October 2004**

### **Waiver of the Copy Requirement in 37 CFR 1.98 for Cited Pending U.S. Patent Applications**

37 CFR 1.98 requires that for each cited pending U.S. patent application, an information disclosure statement (IDS) include a legible copy of the application specification, including the claims, and any drawing of the application, or that portion of the application which caused it to be listed, including any claims, directed to that portion. See 37 CFR 1.98(a)(2)(iii).

The United States Patent and Trademark Office (USPTO) has been scanning newly filed patent applications and the existing inventory of patent applications into USPTO's Image File Wrapper (IFW) system since June of 2003. See Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form, 1271 Off. Gaz. Pat. Office 100 (June 17, 2003). Applications stored in the IFW system may be viewed by examiners on their desktop computers. Consequently, there is no longer a need to require a copy of the specification, including claims, and drawings of a U.S. patent application (or portion of the application) listed on an IDS when the cited application is stored in the USPTO's IFW system, and can be readily viewed by examiners, applicants and members of the public.

Therefore, the requirement in 37 CFR 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent application (or portion of the application which caused it to be listed) is sua sponte waived where the cited pending application is stored in the USPTO's IFW system. See 37 CFR 1.183. This waiver is effective immediately.

Applications filed under 35 U.S.C. 111 on or after June 30, 2003, and international applications that have entered the national stage on or after June 30, 2003, have been or are being scanned into the USPTO's IFW system. When citing to a pending application filed under 35 U.S.C. 111 before June 30, 2003, or that entered the national stage before June 30, 2003, the applicant may check the private Patent Application Information Retrieval (PAIR) System to see whether the application is stored in the USPTO's IFW system in order to determine if a copy of the application (or portion of the application) is required to be provided with an IDS. The private PAIR System can be accessed over the Office's Internet Web site ([www.uspto.gov](http://www.uspto.gov)).

When citing to a pending U.S. patent application that has been published under 35 U.S.C. 122(b) (eighteen-month publication), the USPTO prefers that the citation be to the patent application publication (by publication number) rather than to the application itself (by application number).

This waiver is limited to the specification, including the claims, and drawings in the U.S. application (or portion of the

application). If material other than the specification, including the claims, and drawings in the file of a U.S. patent application is being cited in an IDS, the IDS must contain a legible copy of such material. See 37 CFR 1.98(a)(1)(iv).

Inquiries concerning this notice may be directed to Jeanne M. Clark, Senior Legal Advisor, Office of Patent Legal Administration, at (703) 306-5603.

KUNIN

for

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STEPHEN G.

Deputy Commissioner

Patent Examination